

REMARKS

The Office Action of November 7, 2005 has been received and carefully reviewed. Applicants submit that pending claims 1-20 are patentable over the proposed combinations of the cited references to Link, Amin, Immonen, and Fish and respectfully request reconsideration thereof in view of the following remarks.

I. REJECTION OF CLAIMS 3-9, 11, 13, 14, AND 16-20 UNDER 35 U.S.C. §103

Claims 1, 3-9, 11, 13, 14, and 16-20 were rejected on pages 2-6 of the Office Action under 35 U.S.C. §103 as being unpatentable over U.S. Application Publication No. US 2003/0181202 to Link in view of U.S. Application Publication No. US 2004/0198361 to Amin. These same claims were also rejected on pages 8-12 of the Office Action as obvious with respect to Link in view of U.S. Application Publication No. US 2002/0077091 to Immonen. Reconsideration and withdrawal of these claim rejections is respectfully requested under 35 U.S.C. §103 for at least the following reasons.

a. Link, Amin, and Immonen fail to teach or suggest receiving a request to add or modify a selective mid-call forwarding feature as set forth in claims 1, 3-9, 11, 13, and 14

In order to establish *prima facie* obviousness, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In the present case, Applicants respectfully submit that the proposed combinations of Link with Amin or Immonen fail to teach all the elements of the rejected claims.

Applicants initially note that ***Link does not teach or suggest receiving a request to add a feature to a service plan***. In this regard, ***independent claim 1 recites receiving a request to add the selective mid-call call forwarding feature to the service plan*** from a user, wherein the request is initiated by the user via the mobile station. Independent ***claim 11*** in step d) ***recites receiving a request to modify the selective mid-call call forwarding feature*** from the user via the mobile station. With respect to independent claims 1 and 11, the Office Action asserts on pages 2, 4, 8, and 10 that Link teaches receiving a request to add a selective call forwarding feature to a service plan initiated by a user *via* a mobile station, with reference to Link figures 3, 10, and paragraphs 0056-0059. However, the cited portions of Link do not refer to adding or modifying a feature of a service plan. Instead, paragraphs 0056-0059 and Fig. 3 of

Link appear to illustrate operation of the ATF device 100 utilizing a Short Messaging Service (SMS) to transmit telephone service forwarding instructions to a home Mobile Telephone Switching Office (Home MTSO 310).

Applicants submit that a person of ordinary skill in the art would understand this operation of the system of Link as causing the wireless unit 110 to transmit an SMS forwarding message including the forwarding directory number 130 and forwarding instructions addressed to the automatic call redirection equipment (ACRE) platform 320. In this regard, paragraph 0043 of Link specifies that the ACRE platform 320 implements the forwarding function by emulating a Visitor Location Register (VLR) for an MTSO where the wireless unit is registering for roaming service, where the ATF device 100 causes the wireless unit 110 to place a telephone call to a predefined directory number assigned to the ACRE platform 320 that is configured to receive telephone service redirection instructions. Applicants submit that ***the functionality described in paragraphs 0056-0059 of Link does not constitute adding a selective call forwarding feature to a service plan. Rather, the cited portions of Link appear to perform call redirection without changing or modifying the wireless subscriber's service plan.***

The secondary reference ***Amin does not appear to remedy this deficiency of Link***, whereby the proposed combination of Link with Amin fail to teach every element of the claims. In Amin, a screening list is stored in a cell phone, where the list specifies calling party numbers and associated call handling (paragraphs 0001, 0006, 0022, 0026, 0032, 0054, 0072, Fig. 2). ***The screening list of Amin is not updated by phone***, but rather is updated *via* a personal computer (paragraphs 0017, 0022, 0024, 0033-0035, 0046-0050). The computer transmits the updated list *via* a communication network to a message center, which then sends the list to the cell phone. Thus, Amin fails to teach or suggest receiving a request from a user ***via the mobile station*** to add or modify a mid-call forwarding feature of a service plan.

The secondary reference ***Immonen likewise fails to teach or suggest receiving a request from a user to add or modify a mid-call forwarding feature of a service plan***, whereby the proposed combination of Link with Immonen fail to teach every element of the claims. Immonen is directed to call forwarding methods in which subscriber equipment from which calls have been forwarded is monitored even after the subscriber unit to which the calls have been forwarded has been notified of the incoming call in order to see whether the user takes some pre-defined action, such as

lifting the receiver. In this manner, Immonen allows a subscriber who has activated call forwarding from a fixed-wire telephone to a mobile telephone to take an incoming call on the fixed-wire telephone even if it is not ringing. However, Immonen appears to disclose nothing with respect to adding or modifying features of a service plan, and is silent with respect to receiving a request from a user via the mobile station to add or modify a mid-call forwarding feature of a service plan.

Applicants therefore submit that ***neither Link, Amin, Immonen, nor combinations thereof teach or suggest receiving a request from a user via the mobile station to add or modify a mid-call forwarding feature of a service plan*** as set forth in Applicants' claims. For at least this reason, therefore, claims 1, 3-9, 11, 13, and 14 are patentably distinct from the proposed combinations of Link with Amin or Immonen, and Applicants request reconsideration and withdrawal of the rejections thereof under 35 U.S.C. §103.

b. The proposed combinations of Link with Amin or Immonen also fail to teach other elements of independent claims 1 and 11.

The method of independent claim 1 also includes retrieving a service plan from a subscriber database, and modifying the service plan in conjunction with one or more user selections associated with the change selection menu, after receiving a user request *via* the mobile station to add the selective mid-call call forwarding feature to the service plan from a user. Independent claim 11 recites retrieving a service plan from a subscriber database, reporting the status of the selective mid-call call forwarding feature in the service plan to the user in response to the status request, and modifying the selective mid-call call forwarding feature in the service plan in conjunction with one or more user selections associated with the change selection menu. The Office Action at pages 2, 4, 8, and 10 alleges that Link teaches all these claim elements.

Applicants, however, submit that ***Link fails to teach or suggest retrieving a service plan from a subscriber database*** (independent claims 1 and 11). In contrast to the present invention, Link is directed to an automatic telephone forwarding (ATF) device that automatically enables conventional call forwarding for all calls while the wireless device is connected to the ATF. In general, the ATF devices of ***Link appear to cause all calls to be forwarded*** upon detecting a triggering event, such as placement of a wireless phone in a socket of a base structure, or pressing a forward button (paragraphs [0011], [0015], [0018], [0035], [0043], [0048], [0055], [0057], [0059], [0063], [0065], [0067], [0069], [0072]-[0073], etc.). In this regard, the ATF device of ***Link does***

not appear to retrieve a service plan, but instead merely activates automatic call forwarding to a predefined number.

Link also fails to teach or suggest reporting the status of the selective mid-call call forwarding feature in the service plan to the user in response to the status request from the user's mobile station, as set forth in independent claim 11. Rather, as discussed above, Link teaches nothing with respect to selective mid-call forwarding and hence does not report anything regarding such services to the user. Furthermore, Link appears silent with respect to reporting plan feature status generally.

In addition, ***Link also fails to teach or suggest modifying a service plan*** in conjunction with one or more user selections associated with the change selection menu, as set forth in independent claims 1 and 11. Instead, as described in paragraph 0018 of Link, the ATF device transmits a message instructing a telephone redirection device to forward telephone calls placed to the mobile device directory number to the forwarding directory number by causing the telephone device to transmit a forwarding message to the telephone redirection device on an overhead data channel associated with a wireless communications network, or by other alternative techniques described in paragraphs 0019-0020 of Link. Importantly, none of these approaches in Link appear to involve actually modifying the user's service plan. Indeed, the motivation for the ATF device in Link appears to be directed to providing automatic call forwarding while the mobile phone is in the ATF device, which ends when the mobile phone is again powered up. ***Thus, Link fails to teach or suggest modification of a user's service plan, and in fact appears to teach away from this element of Applicant's claims.***

Thus, ***Link fails to teach or suggest many of the claim elements that the Office Action attributes to Link***, and a person of ordinary skill in the art would not be motivated to modify Link or to combine Link with other references to provide these elements. For these additional reasons, therefore, Applicants request reconsideration and withdrawal of the rejections of claims 1, 3-9, 11, 13, and 14 under 35 U.S.C. §103.

c. No motivation for the proposed combinations of Link with Amin or Immonen with respect to selective mid-call forwarding of claims 1, 3-9, 11, 13, 14, and 16-20

A *prima facie* case of obviousness under 35 U.S.C. §103 also requires some suggestion or motivation in the references themselves, in the nature of the problem to be solved, or in the knowledge generally available to one skilled in the art to modify the reference or to combine references. MPEP §2143.01, citing to *In re Kotzab*, 217 F.3d

1365, 55 USPQ2d 1313 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The showing of such suggestion or motivation must be clear and particular, rather than based on conclusory rationale. In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430 (Fed. Cir. 2002); In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). In addition, there must be a reasonable expectation of success in making the proposed modification or combination. MPEP §2143.02, See also Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 56 USPQ2d 1456 (Fed. Cir. 2000). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Moreover, If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Further, If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious, In re Fine. Applicants submit that ***no suggestion, motivation, or reasonable expectation of success exists for the proposed combinations of Link with Amin or Immonen***, whereby reconsideration and withdrawal of the rejections of claims 1, 3-9, 11, 13, 14, and 16-20 is respectfully requested under 35 U.S.C. §103.

Link does not appear to relate in any way to mid-call forwarding features or addition of such to a service plan, and there is no suggestion or motivation for employing the teachings of Link in combination with Amin or Immonen with respect to mid-call forwarding and modifying these types of service plans. As discussed above, the cited portions of Link appear to perform call redirection without changing or modifying the wireless subscriber's service plan. Moreover, the system of Link allows a user to insert a cell phone into the system in order to automatically enable forwarding of all calls to a predefined number, such as a wireline phone proximate a meeting room. ***Modifying Link to provide selective mid-call forwarding would appear to defeat this goal of Link, whereby a person of ordinary skill in the art would not be motivated to make the proposed combinations with Amin or Immonen or any other reference to implement mid-call forwarding features set forth in Applicants' claims.***

Amin, moreover, appears to teach away from receiving a request to modify the selective mid-call call forwarding feature *from the user via the mobile station.*

In this regard, Amin states:

Since the screening list can become quite complicated, ***it is convenient for the subscriber to have a large visual display,*** which is provided by a personal computer but ***which is not available through an interactive voice response system or through a display on a handheld unit such as a telephone.***

(emphasis added, paragraph 0024). Thus, there is no suggestion, motivation, nor reasonable expectation of success in attempting the proposed combination of Link with Amin or modification of these references with respect to independent claims 1 or 11.

In addition, Applicants note that the Office Action proposes on pages 8 and 11 that Immonen teaches mid-call forwarding features. Applicants submit that rather than teaching selective mid-call forwarding, Immonen appears to instead implement mid-forward override functionality, wherein a previously set forwarding of calls to a wireline phone to a mobile phone can be overridden by the user picking up the wireline phone. In this regard, a person of ordinary skill in the telecommunications art would not look to either Link or Immonen to provide a system capable of the selective mid-call forwarding features of the present invention. Accordingly, Applicants submit that rejected ***claims 1, 3-9, 11, 13, 14, and 16-20 are patentably distinct from the proposed combinations of Link with Amin or Immonen, as there is no motivation, suggestion, or reasonable expectation of success in attempting these combinations,*** and since the proposed combinations fail to teach each and every element of the claims as discussed above, whereby reconsideration and withdrawal of the rejections thereof is requested under 35 U.S.C. §103.

II. REJECTION OF CLAIMS 2 and 12 UNDER 35 U.S.C. § 103

Claims 2 and 12 were rejected under 35 U.S.C. §103 as being obvious with respect to Link in view of U.S. Application Publication No. US 2004/0248591 to Fish and further in view of Amin or Immonen. Reconsideration and withdrawal of the claim rejections under 35 U.S.C. §103 is respectfully requested for at least the following reasons. Claims 2 and 12 depend from independent claims 1 and 11 discussed above in connection with the Link publication reference. These claims recite a further step of verifying the user has authority associated with the subscriber to add the selective mid-call call forwarding feature to the service plan. As discussed above, Link fails to teach

many elements of independent claims 1 and 11, and there is no motivation, suggestion, or reasonable expectation of success in attempting the proposed combinations of Link with Amin or Immonen relative to selective mid-call forwarding. Fish does not appear to remedy the deficiencies of Link regarding mid-call forwarding. Furthermore, Fish fails to provide any motivation or suggestion for the proposed combinations of Link with Amin or Immonen, whereby the proposed combination of Link with Fish and either Amin or Immonen does not render claims 2 and 12 obvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of these claims under 35 U.S.C. §103.

III. CLAIM OBJECTIONS

Claims 10 and 15 were objected to in the Office Action, but were indicated as allowable if rewritten in independent form. Because the corresponding independent claims 1 and 11 are believed to be patentable, claims 10 and 15 are thus believed to be in condition for allowance in dependent form, wherein reconsideration and withdrawal of the objections thereto is respectfully requested.

CONCLUSION

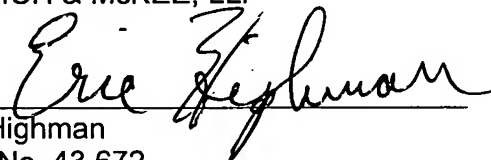
For at least the above reasons, the currently pending claims are believed to be in condition for allowance and notice thereof is requested.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should any fees be due as a result of the filing of this response, the Commissioner is hereby authorized to charge the Deposit Account Number 06-0308, LUTZ200232.

Respectfully submitted,

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